

**REMARKS**

Claims 1-9 and 11-28 were pending, with claims 1, 5, 6, 8 and 19 being independent. In order to expedite prosecution or reduce issues on appeal, independent claims 5 and 6 have been canceled without prejudice/disclaimer to the subject matter embodied thereby; and each of independent claims 1, 8 and 19 have been amended to incorporate the subject matter of claims 26, 27 and 28, respectively. Claims 26-28 have therefore been canceled. It is respectfully submitted that the enclosed amendment does not raise new issues that would require further consideration as the subject matter incorporated into claims 1, 8 and 19 has already been fully considered by the Examiner. Accordingly, entry of the amendment is respectfully requested in order to reduce issues on appeal if the Examiner maintains the pending rejections against claims 26-28 now listed as claims 1, 8 and 19, respectively.

The Examiner has again set forth multiple prior art rejections against the pending claims. Specifically, the Examiner relies on newly cited Elrod et al. '034 ("Elrod"), Coville et al. '956 ("Coville") and Sekiyama et al. '447 ("Sekiyama"). As a preliminary matter, it is noted that Coville et al. '956 has not been formally listed by the Examiner on the PTO-892 form, and instead, the Examiner lists related USP No. 6,740,240 to Coville et al.. It is respectfully requested that Coville et al. '956 also be listed in a PTO-892, attached to a future Office Action, so as to make the record complete.

In each of the § 102 rejections, the Examiner relies on Elrod, Coville and Sekiyama as allegedly disclosing the features of the present invention related to detecting a light which is traversed by a rising surface of the sample solution and outputting an output signal corresponding to the detection. It should be noted that Elrod can be removed as prior art in view of the priority document for the present application.

However, although the Examiner also rejects claim 26 as being anticipated by Sekiyama (and Elrod), the Examiner does not address this specific feature of the present invention. In imposing the rejection under 35 U.S.C. §102, the Examiner is required to point to "page and line" wherein an applied reference is perceived to identically disclose each feature of a claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

Nonetheless, it is respectfully submitted that none of the cited prior art discloses or suggests wherein step (b) is performed based on a change over time in the output signal as now recited in claims 1, 8 and 19. Rather, Sekiyama and Elrod at best disclose *discrete* measurements of light to verify the amount of fluid held in the container, rather than a change over time of the light measurement. For example, in Sekiyama, the laser sensor detects when the liquid level reaches a desired line (*see* col. 12, line 18 – col. 13, line 50 of Sekiyama). It should be noted that multiple discrete measurements over time would each be independent from one another and therefore would not be a basis for verifying that a predetermined amount of solution is held at a given point in time. That is, multiple discrete measurements does not necessitate that the change over time *itself* would be used for verification.

Indeed, one of the objects of the present invention is based on utilizing the change over time of the output signal as a basis for the verifying step (*see, e.g.*, page 17, line 6 – page 19, line 5 of Applicants' specification). For example, as described in Applicants' specification, both the detected output signal "S" at a given time and *the change over time of "S" (i.e.,  $dS/dt$ )* can be used *together* as parameters (opposed to multiple discrete measurements of just "S") to confirm the verification to ensure that bubbles, etc., do not influence the measurement (*see, e.g., page 18, lines 15 – 23 of Applicants' specification*).

As anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed, either expressly or inherently (noting that "inherency may not be established by probabilities or possibilities", *Scaltech Inc. v. Retec/Tetra*, 178 F.3d 1378 (Fed. Cir. 1999)), in a single prior art reference, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986), based on the forgoing, it is submitted that the cited prior art does not anticipate claims 1, 8 and 19, nor any claim dependent thereon.

With respect to the § 103 rejection, it is noted that Kikuchi is relied upon merely for allegedly disclosing a urine level sensor generally while Elrod and Sekiyama are relied upon for the verification. Indeed, the Examiner admits that Kikuchi does not disclose the verification. Accordingly, even assuming *arguendo* proper, the proposed combination does not disclose or suggest each and every limitation of the pending claims. The Examiner is directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard for establishing obviousness under § 103:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejection does not "establish *prima facie* obviousness of [the] claimed invention" as recited in the pending claims because the proposed combination fails the "all the claim limitations" standard required under § 103.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claims 1, 8 and 19 are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also

patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejections under 35 U.S.C. § 102/103 be withdrawn.

### CONCLUSION

Having fully and completely responded to the Office Action, Applicant submits that all of the claims are now in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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